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09/318,447	05/25/1999	PERI HARTMAN	23984-12275	1430
758 7590 09/04/2009 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER				
FADOK, MARK A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/318,447

Applicant(s)

HARTMAN ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 108-116, 124, 125, 151-154, 157 and 176-182 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 6/15/2009

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 2/2/2009, which was received 6/2/2009. Acknowledgement is made to the amendment to claims 108, 151 and 176 and the cancellation of claims 117, 155 and 183, leaving claims 108-116, 124, 125, 151-154, 157, 176-182 as pending in the instant application. Applicant's amendment and remarks have been carefully considered and were found persuasive in regards to the USC 112 rejection of claims 117, 155 and 183 which were canceled thus obviating the rejection of these claims under USC 112.

Examiner's Note

Based on applicant's arguments and since there is no direct support in the specification for "without requiring a user to log into the server system". The examiner understands this phrase to mean that an authentication is required by the server to access a program (see applicant's response received 6/2/2009 pages 7 - 8 and Microsoft Dictionary definition). The user needs to provide a user ID/password to authenticate and gain access to the server to change the profile of the user whereas if the user is purchasing an item using a single action, the cookie that is sent from the client by the client and is used by the server to authenticate the client and permit the purchase process to proceed i.e. no log in/authentication is made by the user because the client browser is sending the authentication information used to gain access.

Information Disclosure Statement

The information disclosure statement filed 6/15/2009 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. In this case cite numbers C12,C49,C104,C111,C171,C199,C244-C249,C251,C291-C294,C298,C327-C336,C342,C343,C412,C427,C432 could not be located. In regards to C158, this reference was provided by applicant on a CD but the CD could not be read because it was not provided in ASCII format as required by the MPEP. There were numerous articles concerning Http, however, since the documents were not each identified as being associated with a particular citing and citing C427-C431 did not include any information regarding the specifics of the various documents the examiner could not ascertain which references belonged to which citing. In regards to C414, web archive number is listed as ...19961104175635... but should be ...19961104175627.... C416 indicated there are 5 pages, the examiner found 11, C417 indicted 11 pages the examiner only found 5, C339 indicates there are 71 pages, the examiner only found 63, C304 indicates there are 85 pages, the examiner could only find 56, C305 indicates that there are 12 pages the examiner could only find 9 pages.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 108-116, 124, 125, and 176-182 are directed to non-statutory subject matter. Based on Supreme Court precedence see *Diamond v Diehr* 450 US 175, 184 (1981); *Parker v. Flook*, 437 US 584, 588, n. 9 (1978); *Gottschalk v Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject matter (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

In regards to claims 151-154 and 157, data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software

and hardware components which permit the data structure's functionality to be realized, and is thus statutory (MPEP 2106.01). In this case the term "component" is not defined in the specification and is therefore considered to be software per se.

Claim Rejections - 35 USC § 112

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claims 124,125 and 157 are rejected under 35 U.S.C. 112, forth paragraph, for not further limiting the previously set forth claims. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See ** Lowry, 32 F.3d **>at< 1583-84, 32 USPQ2d **>at< 1035 **; In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004) (MPEP2106). Since applicant's discloser merely provides for a printed statement on a web page "(you can cancel within 90 minutes)" (Hartman patent FIG 1A) with no

disclosed functional relationship between the printed material and the substrate, the examiner is not giving the claimed features patentable weight and therefore the claims are not further limiting.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 151-154 and 157 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case the examiner cannot determine what the scope of the term "component" is inferring.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 108-116, 124, 125, 151-154, 157 and 176-182 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case applicant argues that the prior art has two distinct steps and that the instant invention only has only one, however, applicant is providing a second step where further interaction from the user is required

including a log in sequence that is not required by the claim in the preceding step.

Applicant's 411 patent col 4, lines 33-35 indicates that single action ordering is accomplished unless the purchaser takes some other action to modify the order. In this case the single action order is stopped when the second part of the claim is accomplished by requiring the user to further interact with the server in order to change the account information. One skilled in the art would not be able perform a single action order based on the claimed process as a whole.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 108-113, 117, 151-155, 176-180,183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (US 5,963,915) in view of Levy (article see PTO 892, recaptured from IDS dated 1/12/2009 in copending case 11618452) or Joseph (US 5,819,034).

In regards to claim 108,151,176 Kirsch discloses a method in a client system for ordering an item, the method comprising:

receiving from a server system a client identifier of the client system (cookie data col 8, lines 10-20); persistently storing the client identifier at the client system (Abstract);

for an item to be ordered, providing for display information identifying the item and an indication of a single action that is to be performed to order the identified item (col 8, lines 64 - col 9, lines 4); and

in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier without requiring a user having to log in to the server system (col 13, lines 15-67, client sends ID and password to server by appending the ID to the product URL which requires no log in by the user since the client identifies the user's account with a cookie that is sent with the URL to the server. It is further noted that the confirmation form being sent to the client browser is a preferred embodiment (col 13, lines 54 and 55 see also col 8, lines 60-65, cookie obviates the need for the client user to re-authenticate manually, i.e. user does not need to log in).

Kirsch teaches that a one click order request is provided to a server that includes sending to the server system a request to order an identified item along with a client identifier that authenticates and identifies the account information of the user stored on the server (col 8, lines 13-20). The server then gathers all the information required to execute a transaction and provides a confirmation page to the customer to confirm that the order is correct before being processed (col 9, lines 1-3). Kirsch further implicitly

contemplates an order being purchased with just one of the phases in that Kirsch states the confirmation form being sent to the client browser is a preferred embodiment (col 13, lines 54 and 55). Also, col 8, lines 60-65, the cookie obviates the need for the client user to re-authenticate manually, i.e. user does not need to log in, suggesting that the confirmation step is not needed to complete the transaction). Kirsch also teaches that "that the determination of when to send a confirmation 108 can be made subject to the dollar amount of the purchase, the client user's purchase history, or other criteria..." (Kirsch col 15, lines 3-5). However, Kirsch does not explicitly teach that there is not a confirmation page sent to the buyer or that the confirmation page does not require action on the part of the user. Levy teaches "You're cruising the Net, hopping from link to link with your favorite browser. In a small window in the corner of your screen sits a ledger. "\$100.00," it reads. As you land on a favorite Web site, something strikes your fancy--an annotated bibliography of every article ever written about Sandra Bullock! Only five bucks. You click on a button, and the file is downloaded to your computer. That tiny ledger on your screen now reads "\$95.00."" which consummates and order without a confirmation page (Levy, page 1). As a further showing, Joseph, in the same field as the instant invention (applicant's patent "441" teaches the use of the instant invention in a television based system) also teaches the use of a single action method where an order is placed and a confirmation page is sent that does not require any action on the part of the user (Joseph, col 8, line 53- col 9, line 2). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Kirsch processing the order without a confirmation step or providing a confirmation

where no action is required by the user, because this would remove redundant user input when staging a transaction over the internet (Kirsch, col 4, lines 65-67) and thus save time by the user.

the client identifier identifying account information previously supplied by a user of the client system (Kirsch, col 8, lines 13-20, and col 13); and
responsive to a request to change account information,
receiving log in credentials of the user;
receiving updated account information (col 14, lines 60-65)
sending the updated account information to the server system (col 5, lines 22-27 and col 14, lines 45-65).

The feature in claim 176, "generating an order for the identified item using the account information associated with the received client identifier" can be found in Kirsch FIG 3, item 82, col 8, line 10-35 and col 14, lines 1-20. For the feature in claim 176, "updating the account information associated with the client identifier of the logged in user based on the received updated account information" see Kirsh, col 14, lines 55-65.

In regards to claim 109,152,177 the combination of Kirsch and Levy teaches wherein the account information includes billing information (Kirsch, col 12, line 55 – 67).

In regards to claim 110,153,178, the combination of Kirsch and Levy teaches wherein the account information includes shipping information (Kirsch, col 12, line 55 – 67).

In regards to claim 111,179, the combination of Kirsch and Levy teaches wherein the client system and server system communicate via the Internet (Kirsch, FIG 1).

In regards to claim 112, the combination of Kirsch and Levy teaches receiving from the server system a confirmation that the order was generated (Kirsch, col 8, lines 25-34).

In regards to claim 113,154,180, the combination of Kirsch and Levy teaches the single action is clicking a mouse button for a cursor is positioned over a predefined area of the displayed information" (Kirsch, col 1, lines 40-53).

Claims 124, 125 and 157 are rejected under 35 U.S.C. 103(e) as being anticipated by Kirsch (US 5,963,915) in view of Levy (article see PTO 892, recaptured from IDS dated 1/12/2009 in copending case 11618452) or Joseph (US 5,819,034) in view of Gulack or in view of Hendricks et al (US 6,539,548).

In regards to claim 124,125,157, the combination of Kirsch and Levy or Joseph teaches a display screen for providing information interactively with a user and permitting cancellation of orders, but does not specifically mention that the information provided is an indication that the order for the item that is requested in response to performing the single action can be canceled within a time period (i.e. "You can cancel within 90 minutes" (applicant's drawing FIG 1A)). However, these differences are only found in the non-functional data provided. Data displayed on a web page providing information is not functionally related to the substrate of the invention. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide information such as "You can cancel within 90 minutes" as part of the graphical and text information on a web page as is taught by Kirsch (Kirsch, col 1, lines 40-45, quality text and graphical based information), because such data does not functionally relate to the substrate of the invention and merely labeling the information provided on the web page differently from that in the prior art would have been an obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

As an alternative rejection, the combination of Kirsch and Levy or Joseph teaches a display screen for providing information interactively with a user and

permitting cancellation of orders (Kirsch col 14, lines 1-20), but does not specifically mention that the order may be canceled in a finite period of time. Hendricks teaches that an order may be canceled within a period of time designated by the seller (FIG 29a and col 37, lines 25-30, "notification of cancellation is provided to the user one or more minutes before a charge is made" which is inclusive of all times including 90 minutes. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Kirsch and Levy or Joseph an indication that the order may be canceled in a finite period of time as is taught by Hendricks, because this provides a convenient mechanism for canceling an order that is no longer desired before a charge is made to the customer account, thus assuring that the customer was given an opportunity to cancel an unwanted order thus increasing the satisfaction of the user.

Claims 114-116,181,182 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (US 5,963,915), in view of Levy or Joseph and further in view of Official Notice.

In regards to claim 114-116,181,182, the examiner takes Official Notice that displaying partial information to protect the user's personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Kirsch and Levi or Joseph,

providing partial information, because providing only partial information has notoriously been known to protect the user's identity and personal information from theft.

Response to Arguments

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Levy and Joseph are introduced to teach that orders placed over the internet were known to be accomplished without a verification step or action required on a confirmation page and that users were aware of the benefits and drawbacks of instantly withdrawing money from an account without having to have a confirmation page or being provided a confirmation page that does not require action on the part of the user. For this reason applicant's argument that Levy does not teach other aspects of the claim is irrelevant.

Applicant's arguments that Kirsch does not teach a single action order are moot in light of the new ground of rejection provided above.

Applicant argues that Kirsch does not teach "responsive to a request to change account information: receiving log in credentials of the user. The examiner disagrees and directs the applicant to the examiner's note along with the rejection of the feature

supra. It is clear that Kirsch requires that a user provide a password in order to re-authenticate/login to the server before the server will permit the user to change shipping information.

In regards to claims 114-116,181,182 applicant requests a reference to support the examiner's taking of official Notice of displaying partial information to protect the user's personal information. In response to this request the examiner provides Mitchell which teaches providing partial credit card and other personal information over the internet is important so that the information can be identified by a customer but is difficult for others to use the information illegally since only portions of the information are provided.

In response to applicant's request for more supporting evidence the examiner also provides US 5715399 to Bezos (FIG 3), 5949044 to Walker (FIG 4 and col 10, lines 50-67), 5727163 (FIG 2), and 5960069 to Felger (col 4, lines 58 to col 15, line 13) as further evidence of the old and well known nature of providing partial information for security reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

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571-273-8300 [Official communications; including

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For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Mark Fadok

Primary Examiner, Art Unit 3625